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PATENT APPLICATION

ATTORNEY DOCKET NO. 10004463-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Al-Kazily, et al.

Confirmation No.: 3952

Application No.: 09/814,284

Examiner: Poon, King

Filing Date: 3-21-01

Group Art Unit: 2625

Title: Mailbox Printing Services for Information Appliances

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 10-16-06.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

<input type="checkbox"/> 1st Month \$120	<input type="checkbox"/> 2nd Month \$450	<input type="checkbox"/> 3rd Month \$1020	<input type="checkbox"/> 4th Month \$1590
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☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

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Typed Name: Mary Meegan

Signature: Mary Meegan

Respectfully submitted,

Al-Kazily, et al.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Al-Kazily, et al.

Serial No.: 09/814,284

Filed: March 21, 2001

Confirmation No.: 3952

Group Art Unit: 2625

Examiner: Poon, King

Docket No. 10004463-1

For: **Mailbox Printing Services for Information Appliances**

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Appeal Brief under 37 C.F.R. § 41.37 is submitted in support of the Notice of Appeal filed October 16, 2006, responding to the Final Office Action mailed July 31, 2006.

It is not believed that extensions of time or fees are required to consider this Appeal Brief. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to Deposit Account No. 08-2025.

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I. Real Party in Interest

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. Related Appeals and Interferences

There are no known related appeals or interferences that will affect or be affected by a decision in this Appeal.

III. Status of Claims

Claims 4, 11-14, 18-20 have been canceled leaving claims 1-3, 5-10, 15-17, and 21-33 remaining. Each of those claims stand finally rejected. No claims have been allowed. The final rejections of claims 1-3, 5-10, 15-17, and 21-33 are appealed.

IV. Status of Amendments

This application was originally filed on March 21, 2001, with twenty (20) claims. In a Response filed November 4, 2004, Applicant withdrew claims 11-14 and 18-20. In a Response filed June 28, 2005, Applicant amended claims 1, 15, and added new claims 21-33. In a Response filed October 17, 2005, Applicant amended claims 1, 5, 7, 15, 26, 30 and canceled claim 4.

All of the above-identified amendments have been entered and no other amendments have been made to any of claims 1-3, 5-10, 15-17, and 21-33. The claims in the attached Claims Appendix (see below) reflect the present state of those claims.

V. Summary of Claimed Subject Matter

The claimed inventions are summarized below with reference numerals and references to the written description ("specification") and drawings. The subject matter described in the following appears in the original disclosure at least where indicated, and may further appear in other places within the original disclosure.

Independent claim 1 describes a method performed on an information appliance for printing a document stored on a remote computer. The method of claim 1 comprises providing a connection between an information appliance and a remote computer, wherein the remote computer stores one or more documents in a user mailbox. *Applicant's specification*, page 19, line 33 to page 20, line 2; Figure 6, item 602. The method of claim 1 further comprises transmitting information regarding a list of user mailbox documents stored on the information appliance from the information appliance to the remote computer. *Applicant's specification*, page 20, lines 17-19; Figure 6, item 606. The method of claim 1 further comprises receiving synchronization information from the remote computer, the synchronization information comprising one or more references to one or more documents stored in the user mailbox that are available to a user for printing. *Applicant's specification*, page 20, line 31 to page 21, line 1; Figure 6, item 612. The method of claim 1 further comprises updating the list of user mailbox documents stored on the information appliance using the synchronization information

received from the remote computer. *Applicant's specification*, page 12, lines 2-5. The method of claim 1 further comprises displaying the updated list of user mailbox documents to the user on a display of the information appliance. *Applicant's specification*, page 21, lines 6-7, Figure 7, item 702. The method of claim 1 further comprises receiving a selection of one or more documents from the displayed list of user mailbox documents. *Applicant's specification*, page 21, lines 15-18, Figure 7, item 706. The method of claim 1 further comprises receiving a command to print the one or more selected documents. *Applicant's specification*, page 21, lines 18-20; Figure 7, line 708. The method of claim 1 further comprises responsive to receiving the command to print, transmitting a print request to a nearby printer that instructs the printer to retrieve the one or more selected documents from the user mailbox and print the one or more selected documents. *Applicant's specification*, page 21, line 21-22; Figure 7, item 710.

Independent claim 15 describes a computer-readable storage medium having stored thereon computer instructions that, when executed by an information appliance, cause the information appliance to provide a connection between an information appliance and a remote computer, wherein the remote computer stores one or more documents in a user mailbox. *Applicant's specification*, page 19, line 33 to page 20, line 2; Figure 6, item 602. The system of claim 15 further comprises instructions that cause the information appliance to transmit information regarding a list of user mailbox documents stored on the information appliance from the information appliance to the remote computer. *Applicant's specification*, page 20, lines 17-19; Figure 6, item 606. The system of claim 15 further comprises instructions that cause the information appliance to receive synchronization information from the remote computer, the

synchronization information comprising one or more references to one or more documents stored in the user mailbox that are available to a user for printing. *Applicant's specification*, page 20, line 31 to page 21, line 1; Figure 6, item 612. The system of claim 15 further comprises instructions that cause the information appliance to update the list of user mailbox documents stored on the information appliance using the synchronization information received from the remote computer. *Applicant's specification*, page 12, lines 2-5. The system of claim 15 further comprises instructions that cause the information appliance to display the updated list of user mailbox documents to a user on a display of the information appliance. *Applicant's specification*, page 21, lines 6-7, Figure 7, item 702. The system of claim 15 further comprises instructions that cause the information appliance to receive a selection of one or more documents from the displayed list of user mailbox documents. *Applicant's specification*, page 21, lines 15-18, Figure 7, item 706. The system of claim 15 further comprises instructions that cause the information appliance to receive a command to print the one or more selected documents. *Applicant's specification*, page 21, lines 18-20; Figure 7, line 708. The system of claim 15 further comprises instructions that cause the information appliance to transmit a print request to a nearby printer in response to receiving the command to print that instructs the printer to retrieve the one or more selected documents from the user mailbox and print the one or more selected documents. *Applicant's specification*, page 21, line 21-22; Figure 7, item 710.

VI. Grounds of Rejection to be Reviewed on Appeal

The following grounds of rejection are to be reviewed on appeal:

1. Claims 1, 2, 5-10, 15-17, 21, 23-26, 28-30, 32, and 33 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Wolff* (U.S. Pat. No. 6,738,841) in view of *Eldridge, et al.* ("Eldridge," U.S. Pat. No. 6,430,601).

2. Claims 3 and 22 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Wolff* as applied to claims 1, 2, 15, and 21 in view of *Dalton* (U.S. Pat. No. 6,246,211).

3. Claims 27 and 31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Wolff* and *Eldridge* as applied to claims 1 and 15 in view of *Granstam* (U.S. Pat. No. 6,587,691).

VII. Arguments

The Appellant respectfully submits that Applicant's claims are not obvious under 35 U.S.C. § 103, and respectfully requests that the Board of Patent Appeals overturn the final rejections of those claims at least for the reasons discussed below.

Claim Rejections - 35 U.S.C. § 103(a)

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.

In the present case, the prior art does not teach or suggest all of the claim limitations, and there is no suggestion or motivation in the prior art to modify the references to include those limitations.

A. Rejection of Claims 1, 2, 5-10, 15-17, 21, 23-26, 28-30, 32, and 33

Claims 1, 2, 5-10, 15-17, 21, 23-26, 28-30, 32, and 33 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Wolff* (U.S. Pat. No. 6,738,841) in view of *Eldridge, et al.* (“Eldridge,” U.S. Pat. No. 6,430,601). Applicant respectfully traverses this rejection.

1. The Wolff Reference

Wolff discloses a system that can be used to retrieve and print remote documents. In the system, a PDA 930 accesses a server 920 and receives a quote for a “contract” from the server. *Wolff*, column 8, lines 48-55. If after reviewing the quote the PDA user wishes to print out the contract, the user sends a request for the contract from the PDA 930 to a printer 250, which then retrieves the contract from the server 920 and prints it. *Wolff*, column 8, line 66 to column 9, line 14.

Significantly, Wolff says nothing about “synchronizing” a “list of documents” stored on the PDA with any “synchronization information” received from a remote computer.

2. The Eldridge Reference

Eldridge discloses a mobile document paging service. *Eldridge*, Patent Title. Eldridge generally teaches the concept of a mail server. *Eldridge*, column 3, line 31.

3. Discussion of Applicant's Claims

(a) Claims 1-2, 6-7, 9-10, 26, and 28-29

Independent claim 1 provides as follows (emphasis added):

1. A method performed on an information appliance for printing a document stored on a remote computer, the method comprising:

providing a connection between an information appliance and a remote computer, wherein the remote computer stores one or more documents in a user mailbox;

transmitting information regarding a list of user mailbox documents stored on the information appliance from the information appliance to the remote computer,

receiving synchronization information from the remote computer, the synchronization information comprising one or more references to one or more documents stored in the user mailbox that are available to a user for printing;

updating the list of user mailbox documents stored on the information appliance using the synchronization information received from the remote computer,

displaying the updated list of user mailbox documents to the user on a display of the information appliance;

receiving a selection of one or more documents from the displayed list of user mailbox documents;

receiving a command to print the one or more selected documents;
and

responsive to receiving the command to print, transmitting a print request to a nearby printer that instructs the printer to retrieve the one or more selected documents from the user mailbox and print the one or more selected documents.

In the final Office Action, the Examiner argued that Wolff teaches or suggests every limitation of claim 1 with the exception of documents being stored in a mailbox and served by a mailbox server. *See Final Office Action*, pages 1-4. In reaching that conclusion, the Examiner relied upon the disclosure provided in relation to Wolff's columns 8 and 9 and Figure 9. Applicant disagrees with the conclusion that Wolff teaches or suggests the other limitations of claim 1 for reasons described below.

In claim 1, Applicant claims a method in which a list of documents stored on an appliance are *synchronized with* a list of the user's documents stored on a remote computer before the user instructs a local printer to retrieve a document from the remote computer for printing. In such a case, the user of the appliance can determine which of his or her documents are resident on the remote computer and therefore available for printing. Wolff, however, teaches nothing of the sort. Instead, as described above, Wolff merely teaches downloading to a PDA a quote for a contract and then instructing a printer to download the contract from the remote computer for printing. Therefore, contrary to that argued by the Examiner, Wolff does not teach any of:

(i) "transmitting information regarding a list of user mailbox documents stored on the information appliance from the information appliance to the remote computer",

(ii) "receiving synchronization information from the remote computer, the synchronization information comprising one or more references to one or more documents stored in the user mailbox that are available to a user for printing",

(iii) “updating the list of user mailbox documents stored on the information appliance using the synchronization information received from the remote computer”, or

(iv) “displaying the updated list of user mailbox documents to the user on a display of the information appliance”.

Applicant discusses each of those limitations in the following.

(i) “Transmitting . . . List of User Mailbox Documents”

In the synchronization process described in claim 1, included is the step of “transmitting information regarding a list of user mailbox documents stored on the information appliance from the information appliance to the remote computer”. With regard to that limitation the Examiner argued that Wolff teaches transmitting a list of user documents from an information appliance to a remote computer because Wolff’s PDA can “select one or more quotes/document” from a remote computer. *Final Office Action*, page 2. As to that argument, Applicant notes that “selecting” a document *from* a remote computer clearly does not equate to “transmitting” a “list of documents” from an appliance *to* the remote computer. Specifically, when the user in Wolff’s system downloads a webpage that identifies documents stored on a remote computer that are available for viewing on the PDA, “selection” of one of those documents is not transmitting a “list” of documents to the remote computer. Moreover, such “selection” is not transmitting a list that is “stored on the information appliance”. Therefore, the above-referenced Examiner argument regarding the “transmitting” limitation is without merit.

The Examiner further stated in the final Office Action that the Examiner interprets transmitting information regarding a list of user mailbox documents from the information appliance to the remote computer as a “request to print.” *Final Office Action*, page 10. In response, Applicant asserts that the Examiner’s interpretation is neither supported by the plain and ordinary meaning of the claim limitation nor by Applicant’s specification. As to the plain and ordinary meaning of the claim limitation, “requesting printing” cannot reasonably be considered to be the same as, or even suggestive of, transmitting a list of documents. For example, if the user in Wolff’s system were to “click on” a document to communicate to a remote computer a desire to print the document, that action clearly is not equivalent to transmitting a list of documents to the remote computer.

Turning Applicant’s specification, Applicant explicitly describes a process performed by a mailbox server (i.e., remote computer) and an information appliance in which a list of documents is transmitted from the information appliance to the server to facilitate synchronization. As provided in Applicant’s specification:

In one embodiment, the mailbox server 104 transmits a request, for example, over connection 110 requesting that the information appliance 102 transmit the document list currently stored on the information appliance. The mailbox server 104 may then compare the document list received from the information appliance 102 with the document in the user’s mailbox 302 to determine if the document list on the information appliance is out of date. . . . If, at step 610, the mailbox server 104 determines that the document list on the information appliance 102 is out of date, the mailbox server 104 transmits a current document list to the information appliance 102 at step 612.

Applicant's specification, page 20, line 17 to page 21, line 1 (portion omitted). Therefore, the “transmitting” limitation should be interpreted as it reads: actually transmitting a list of documents stored on an appliance from the appliance to a remote computer. Applicant notes that the specification must be considered in interpreting the claims. See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995)(in banc), *aff'd*, 517 U.S. 370, 38 USPQ2d 1461 (1996) (“Claims must be read in view of the specification, of which they are a part”).

In view of the above, it is clear that Wolff neither teaches nor suggests transmitting a list of documents stored on the appliance from the appliance to a remote computer. Given that the Eldridge reference similarly fails to teach or suggest that action, it follows that the references do not “teach or suggest all the claim limitations” as required by MPEP § 2143. Applicant therefore respectfully requests that the rejections against claim 1 and its dependents be withdrawn for at least that reason.

(ii) “Receiving Synchronization Information”

Regarding the “receiving synchronization information” limitation, the Examiner argued that Wolff teaches “receiving information” from the remote computer. *Final Office Action*, page 2. In reply, Applicant asserts that claim 1 does not merely recite “receiving information.” Instead, claim 1 explicitly requires receiving “synchronization” information with the appliance. Wolff’s teaching of a PDA receiving a “quote” or a “document” from a remote computer clearly does not equate with receiving synchronization information.

Applicant objects to the Examiner's disregard of Applicant's explicit claim limitations in adjudging the patentability of Applicant's claims. Such disregard is particularly troubling given that the meaning of the term "synchronization" would certainly be imputed to Applicant's claims if they were ever asserted against an infringer. Applicant therefore asserts that the meaning of the term "synchronization" must be taken in consideration when determining the patentability of Applicant's claims. As described above, the meaning of the term "synchronization" is clear from Applicant's specification, which explicitly describes a synchronization process in which a remote computer compares a list stored on the appliance with its own resident list to determine whether synchronization is necessary and, if so, sends its resident list to the appliance to enable synchronization of the list stored on the appliance with the list stored on the remote computer. Neither applied reference teaches any such synchronization process.

(iii) "Updating the List"

Next, regarding "updating the list" limitation, the Examiner argues that because Wolff teaches refreshing a home page accessed with a PDA, Wolff therefore teaches updating a list of user mailbox documents stored on a information appliance using synchronization information received from the remote computer. *Final Office Action*, page 3. In reply, Applicant asserts that the Examiner is improperly evaluating the limitations of claim 1 in a piecemeal fashion instead of considering the claim as a whole. See *Hartness International, Inc. v. Simplimatic Engineering Co.*, 819 F.2d 1100, 2 USPQ2d 1826 (Fed. Cir. 1987). In the present case, Applicant is not merely describing refreshing a web page, but is explicitly claiming updating a list documents *that was*

already transmitted from the appliance to the remote computer. When the “updating” limitation is considered in the context of the whole claim it is apparent that: (i) the appliance transmits a list to a remote computer, (ii) the remote computer replies with synchronization information, and (iii) the appliance updates the list it previously sent relative to the synchronization information. Therefore, the same list that was transmitted from the appliance to the remote computer is updated using synchronization information received from the remote computer. Even assuming that Wolff’s description of refreshing a web page is “updating” the information of that web page, Wolff clearly does not teach updating a “list of documents” that was already “transmitted” from an information appliance to a remote computer.

(iv) “Displaying the Updated List”

Finally, regarding the “displaying the updated list” limitation, Applicant notes that since no “list of user mailbox documents” that was transmitted from an appliance is “updated” in Wolff’s process, it logically follows that Wolff does not teach displaying such an “updated list” on an appliance.

(v) Dependent Claims

In view of the foregoing, it is clear that claim 1 is allowable over Wolff and Eldridge fail to teach or suggest several limitations of claim 1. Applicant notes that the claims that depend from claim 1 contain further limitations that are not taught or suggested by Wolff and Eldridge.

Regarding dependent claim 26, neither Wolff or Eldridge teach or suggest that the “information” transmitted from the information appliance to the remote computer is a “list of user mailbox documents”, the list being stored on the information appliance. Again, no list is transmitted from Wolff’s information appliance to a remote computer. Further, no list identifying “user mailbox documents” is transmitted.

Regarding dependent claim 28, neither Wolff nor Eldridge teach or suggest that the “references to documents” received by the information appliance from the remote computer comprises one or more of “a Universal Resource Locator (URL), filename, reference number, and an identification number.” Applicant notes that although column 8, lines 25-30 of the Wolff reference generally identify a list of URLs, that list is merely a “table of contents” of information that can be accessed, not “references to documents” that are available for printing.

(b) Claims 15-17, 21, 23-25, 30, and 32-33

Independent claim 15 provides as follows (emphasis added):

15. A computer-readable storage medium having stored thereon computer instructions that, when executed by an information appliance, cause the information appliance to:

provide a connection between an information appliance and a remote computer, wherein the remote computer stores one or more documents in a user mailbox;

transmit information regarding a list of user mailbox documents stored on the information appliance from the information appliance to the remote computer;

receive synchronization information from the remote computer, the synchronization information comprising one or more references to one or more documents stored in the user mailbox that are available to a user for printing;

update the list of user mailbox documents stored on the information appliance using the synchronization information received from the remote computer;

display the updated list of user mailbox documents to a user on a display of the information appliance;

receive a selection of one or more documents from the displayed list of user mailbox documents;

receive a command to print the one or more selected documents;

and

transmit a print request to a nearby printer in response to receiving the command to print that instructs the printer to retrieve the one or more selected documents from the user mailbox and print the one or more selected documents.

Regarding claim 15, Wolff and Eldridge fail to teach or suggest a computer-readable medium that causes an information appliance to (i) "transmit information regarding a list of documents stored on the information appliance from the information appliance to the remote computer", (ii) "receive synchronization information from the remote computer, the synchronization information comprising one or more references to one or more documents stored in the user mailbox that are available to a user for printing", (iii) "update the list of user mailbox documents stored on the information appliance using the synchronization information received from the remote computer", or (iv) "display the updated list of user mailbox documents to a user on a display of the information appliance" for reasons described in relation to claim 1 above. Applicant

therefore submits that claim 15 and its dependents are allowable over the Wolff/Eldridge combination.

Regarding dependent claim 32, Applicant refers above to the discussion of claim 28, which comprises similar limitations.

B. Rejection of Claims 3 and 22

Claims 3 and 22 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Wolff* as applied to claims 1, 2, 15, and 21, and in view of *Dalton* (U.S. Pat. No. 6,246,211). Applicant respectfully traverses this rejection.

As an initial matter, Applicant notes for the *third* time that the rejection is improper given that claims 1 and 15 were rejected in view of Wolff *and* Eldridge. Given that Eldridge is not cited against claims 3 and 22, the rejection is improper and should have been withdrawn during normal prosecution. Applicant considers this reversible error.

As a further matter, Applicant notes that Wolff does not teach several aspects of Applicant's claims 1 and 15. In that Dalton does not remedy the deficiencies of the Wolff reference, Applicant submits that claims 3 and 22, which depend from claims 1 and 15, respectively, are allowable over the Wolff/Dalton combination for at least the same reasons that claims 1 and 15 are allowable over Wolff.

C. Rejection of Claims 27 and 31

Claims 27 and 31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Wolff* and *Eldridge* as applied to claims 1 and 15, and in view of *Granstam* (U.S. Pat. No. 6,587,691). Applicant respectfully traverses this rejection.

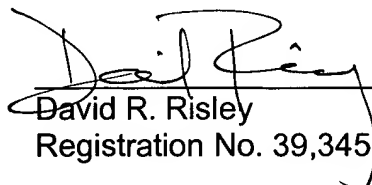
Applicant notes that Wolff and Eldridge do not teach several aspects of Applicant's claims 1 and 15. In that Granstam does not remedy the deficiencies of the Wolff and Eldridge references, Applicant submits that claims 27 and 31, which depend from claims 1 and 15, respectively, are allowable over the Wolff/Eldridge/Granstam combination for at least the same reasons that claims 1 and 15 are allowable over Wolff/Eldridge.

VIII. Conclusion

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,

By:

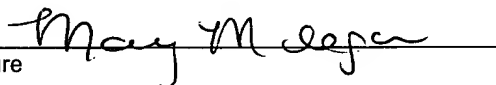

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Claims Appendix under 37 C.F.R. § 41.37(c)(1)(viii)

The following are the claims that are involved in this Appeal.

1. A method performed on an information appliance for printing a document stored on a remote computer, the method comprising:

providing a connection between an information appliance and a remote computer, wherein the remote computer stores one or more documents in a user mailbox;

transmitting information regarding a list of user mailbox documents stored on the information appliance from the information appliance to the remote computer;

receiving synchronization information from the remote computer, the synchronization information comprising one or more references to one or more documents stored in the user mailbox that are available to a user for printing;

updating the list of user mailbox documents stored on the information appliance using the synchronization information received from the remote computer;

displaying the updated list of user mailbox documents to the user on a display of the information appliance;

receiving a selection of one or more documents from the displayed list of user mailbox documents;

receiving a command to print the one or more selected documents; and

responsive to receiving the command to print, transmitting a print request to a nearby printer that instructs the printer to retrieve the one or more selected documents from the user mailbox and print the one or more selected documents.

2. The method of Claim 1, wherein the print request is transmitted over a wireless connection between the information appliance and the nearby printer.

3. The method of Claim 2, wherein the wireless connection conforms to the Bluetooth technology.

4. (Canceled)

5. The method of Claim 1, wherein the print request comprises mailbox server identification information.

6. The method of Claim 1, wherein the print request comprises one or more references identifying the one or more selected documents.

7. The method of Claim 1, wherein the print request comprises user identification information.

8. The method of Claim 1, wherein the remote computer is a mailbox server.

9. The method of Claim 1, wherein the information appliance is a wireless phone.

10. The method of Claim 1, wherein the information appliance is a personal digital assistant.

11-14. (Canceled)

15. A computer-readable storage medium having stored thereon computer instructions that, when executed by an information appliance, cause the information appliance to:

provide a connection between an information appliance and a remote computer, wherein the remote computer stores one or more documents in a user mailbox;

transmit information regarding a list of user mailbox documents stored on the information appliance from the information appliance to the remote computer;

receive synchronization information from the remote computer, the synchronization information comprising one or more references to one or more documents stored in the user mailbox that are available to a user for printing;

update the list of user mailbox documents stored on the information appliance using the synchronization information received from the remote computer;

display the updated list of user mailbox documents to a user on a display of the information appliance;

receive a selection of one or more documents from the displayed list of user mailbox documents;

receive a command to print the one or more selected documents; and

transmit a print request to a nearby printer in response to receiving the command to print that instructs the printer to retrieve the one or more selected documents from the user mailbox and print the one or more selected documents.

16. The computer-readable storage medium of Claim 15, wherein the print request comprises user identification information.

17. The computer-readable storage medium of Claim 15, wherein the print request comprises identification information for the remote computer.

18-20. (Canceled)

21. The computer-readable storage medium of Claim 15, wherein the print request is transmitted over a wireless connection between the information appliance and the printer.

22. The computer-readable storage medium of Claim 21, wherein the wireless connection conforms to the Bluetooth technology.

23. The computer-readable storage medium of Claim 15, wherein the print request comprises one or more references identifying the one or more selected documents.

24. The computer-readable storage medium of Claim 15, wherein the computer-readable storage medium is provided in a wireless phone.

25. The computer-readable storage medium of Claim 15, wherein the computer-readable storage medium is provided in a personal digital assistant.

26. The method of Claim 1, wherein the information regarding a list of documents stored on the information appliance comprises the list of user mailbox documents currently stored on the information appliance.

27. The method of Claim 1, wherein the information regarding a list of documents stored on the information appliance comprises a timestamp that indicates a last time the synchronization information was received from the remote computer.

28. The method of Claim 1, wherein the references to documents stored on the remote computer comprise one or more of a Universal Resource Locator (URL), filename, reference number, and an identification number.

29. The method of Claim 1, further comprising transmitting user identification information to the remote computer prior to the information regarding a list of documents stored on the information appliance.

30. The computer-readable storage medium of Claim 15, wherein the information regarding a list of documents stored on the information appliance comprises the list of user mailbox documents currently stored on the information appliance.

31. The computer-readable storage medium of Claim 15, wherein the information regarding a list of documents stored on the information appliance comprises a timestamp that indicates a last time the synchronization information was received from the remote computer.

32. The computer-readable storage medium of Claim 15, wherein the references to documents stored on the remote computer comprise one or more of a Universal Resource Locator (URL), filename, reference number, and an identification number.

33. The computer-readable storage medium of Claim 15, further comprising computer instructions that, when executed by an information appliance, cause the information appliance to transmit user identification information to the remote computer prior to the information regarding a list of documents stored on the information appliance.

Evidence Appendix under 37 C.F.R. § 41.37(c)(1)(ix)

There is no extrinsic evidence to be considered in this Appeal. Therefore, no evidence is presented in this Appendix.

Related Proceedings Appendix under 37 C.F.R. § 41.37(c)(1)(x)

There are no related proceedings to be considered in this Appeal. Therefore, no such proceedings are identified in this Appendix.

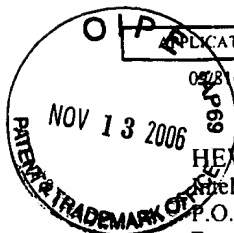


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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
05/28 4,284	03/21/2001	Binnur Al-Kazily	10004463-1	3952

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IPA

EXAMINER

POON, KING Y

ART UNIT

PAPER NUMBER

2625

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



Application No.

09/814,284 ✓

Applicant(s)

AL-KAZILY ET AL.

Examiner

King Y. Poon

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-10,15-17 and 21-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-10,15-17 and 21-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 5-10, 15-17, 21, 23-26, 28-30, 32, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff (US 6,738,841) in view of Eldridge et al (US 6,430,601)

Regarding claims 1, 8, 26: Wolff teaches a method performed on an information appliance (PDA, column 8, line 48) for printing a document (column 8, line 56) stored on a remote computer (server 920, column 9, lines 8-10), the method comprising: providing a connection between an information appliance and a remote computer (fig. 9), wherein the remote computer stores one or more documents; transmitting information regarding documents (PDA can select more than one quotes/documents, column 8, lines 50-55) information stored on the information appliance (inherently if user can view and select the document from the PDA) from the information appliance to the remote computer; receiving synchronization information (the information that causes fig. 10 to be displayed) from the remote computer, the synchronization information comprising one or more reference information to one or more documents stored on the remote computers that are available to a user for printing (fig. 10, identifying document 1000 identifying

contract 1100 being stored in the server 920, column 9, lines 5-15, column 8, lines 65-67; there are more than one documents, column 8, line 55); updating (every time the user accessing the home page, column 8, lines 57-58, the home page will replace/update the previous home page, if the home page has been changed) the documents stored on the information appliance using synchronization information received from the remote computer; displaying the updated documents to the user (fig. 10) on a display of the information appliance; receiving a selection of one or more documents from the displayed information (the PDA must receive a selection from the user in order for the user to request printing the document using the PDA); receiving a command (the signal generated by the user's action of selecting, e.g., the electric signal generated by touching a key) to print the one or more selected documents, and responsive to receiving the command (inherently, all PDA response to command/signal generated by user's action) to print, transmitting a print request (column 9, lines 8-10 and quote 1000, column 8, lines 65-67) to a nearby printer (since it is wireless, column 8, line 49, the PDA can inherently move around; therefore, the printer of Wolff is nearby when the user is walking close to the printer or far away when the user is far away from the printer) that instructs the printer to print the one or more selected documents.

Wolff does not teach the home page of column 8, lines 55-60 contains a list of the quotes/document to be selected by the user.

However, Wolff at column 7, lines 50-55, fig. 6, teaches to display a list of books, in the PDA, for the user to view at one time and to be selected by the user to print.

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(note, the list of books displayed received by the PDA/mobile device are information in synchronization to books being stored).

Since the idea of Wolff's invention is to display information to a user's mobile device such that a user, from the information received, would be able to selected a document from a plurality of documents to be sent to a printer, and the printer retrieve the document from a remote repository to be printed by the printer; it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Wolff to include: home page access by the PDA contains a list of the quotes/document to be selected by the user.

Since the concept of home page access by the PDA contains a list of the quotes/document to be selected by the user, was already taught by Wolff in another embodiment, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Wolff because it would have allowed to see all the document at one time such that the user would select a desired document.

Wolff does not teach wherein the one or more documents are stored in a mailbox and serve by a mail box server to be retrieved by a user, wherein the mailbox is associated with a user.

Eldridge, in the same area of accessing document from a mobile device (118, fig. 1) from document server (column 3, lines 30-35, fig. 1), teaches wherein the one or more documents accessed by a mobile device are stored in a mailbox (column 6, lines 60-63, column 7, lines 25-30, column 7, lines 45-50), wherein the mailbox is associated with a user. Eldridge also teaches it is well known in the art of displaying email from a

mobile device that a mobile device received synchronization information (signal represent a list of email document, fig. 6) from a remote computer (email server, 112, fig. 1), the synchronization information comprising one or more reference to one or more document stored in the user mailbox and from the received signal/synchronization information the user mailbox documents list stored on the mobile device are updated (obviously, the new information received is the most updated information) and displayed.

Wolff, column 5, lines 29-33, teaches that his teaching disclosed in the US 6,738,841, may be applied to various network, data and document storage and archival facilities, or other types of client/server systems that have document or other information available upon request. In other words, there are many other systems that Wolff's invention would be applied to according to Wolff. Those system, although not being disclosed, would have been recognized to a person with ordinary skill in the art.

Since Eldridge's mail server/user mail box facilities/system are network, data and document storage and archival facilities, and client/server systems that have document or other information available upon request and Eldridge's system matches exactly what Wolff suggested to be used with his invention; it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Wolff, as suggest by Wolf to include: wherein the one or more documents are stored in a mailbox and serve by a mail box server, wherein the mailbox is associated with a user.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Wolff because of the following reasons: (a)

email is the most convenient and most widely used by users all over the world way of sending documents; and (b) it would have allowed users to communicate with other users and printing document, images and pictures send from other users located everywhere in the world.

Note: the modified system requires receiving synchronization information from a remote computer (email server, 112, fig. 1), the synchronization information comprising one or more reference to one or more document stored in the user mailbox and from the received signal/synchronization information, the user mailbox documents list stored on the mobile device are updated and displayed.

Regarding claims 2: Wolff teaches wherein the print request is transmitted over a wireless connection (column 8, line 49) between the information appliance and the nearby printer.

Regarding claim 5: Please see discussion of claim 1.

Wolff teaches wherein the print request comprises the mailbox server's identification information (location, fig. 10; the document is located on the mailbox server after the modification by Eldridge; furthermore Wolff teaches printer accessing server using WWW, column 4, lines 55-60, inherently identification of the server is required in order for the printer to access the server from WWW).

Regarding claims 6: Wolff teaches wherein the print request comprises one or more references identifying the one or more selected documents (inherent properties of the print request if the print request is able to control the printer driver 255 to retrieve the document from a document server, column 9, lines 5-20).

Regarding claim 7: Wolff teaches wherein the print request comprises an user identification information (Ogawa, fig. 10, column 8, lines 65-68, the examiner view quote 1000 as part of a print request).

Regarding claim 9: Wolff teaches wherein the information appliance is a wireless phone (column 8, line 44).

Regarding claim 10: Wolff teaches wherein the information appliance is a personal digital assistant (column 8, line 44).

Regarding claim 28: Wolff teaches wherein the references to the documents stored on the remote computer comprises one or more of a URL, filename, reference number and an ID number (fig. 6, column 8, lines 25-30).

Regarding claim 29: Wolff teaches transmitting user ID information to the remote computer prior to the information regarding a list of documents stored on the information appliance (column 8, lines 59-62).

Regarding claims 15, 16: Inherently all PDA are controlled by software and requires a computer readable storage medium having stored computer instruction. Please also see discussion of claims 1, and 7.

Regarding claim 17: Wolff teaches wherein the print request comprises identification information for the remote computer (location, fig. 10; the document is located on the server; furthermore Wolff teaches printer accessing server using WWW, column 4, lines 55-60, inherently identification of the server is required in order for the printer to access the server from WWW).

Regarding claims 21, 23-25, 30, 32, 33: Inherently all PDA are controlled by software and requires a computer readable storage medium having stored computer instruction. Please also see discussion of claims 2, 6, 9, 10, 26, 28, 29.

3. Claims 3, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff (US 6,738,841) as applied to claims 1, 2, 15, 21 above, and further in view of Dalton (US 6,246,211).

Regarding claims 3, 22: Wolff does not teach wherein the wireless connection conforms to the Bluetooth technology.

Dalton, in the same area of wireless communication, teaches it is well known in the art that a PDA communicates with other devices using Bluetooth technology (column 4 lines 10-15).

Since Wolff does not teach the kind of technology that is used in the wireless communication and without a communication protocol/technology, wireless communication does not work; a person with ordinary skill in the art must relies on other teaching/references in order to make use of Wolff.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have use Bluetooth technology for the wireless communication such that the PDA can be able to communicates and using a well establish protocol for communication would ensure the PDA of Wolff can be widely used.

4. Claims 27, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff (US 6,738,841) and Eldridge et al (US 6,430,601) as applied to claims 1, 15 above, and further in view of Granstam (US 6,587,691).

Regarding claims 27, 31: Wolff does not teach wherein the information regarding a list of documents comprises a timestamp indicates a last time the synchronization information was received from the remote computer.

Granstam, in the same area of PDA, teaches it is well-known in the art that PDA time stamp received information indicating the last time the information is received (column 10, lines 19-24).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Wolff to include: wherein the information regarding a list of documents comprises a timestamp indicates a last time the synchronization information was received from the remote computer.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Wolff by the teaching of Granstam because it would have allowed the PDA to properly manage all messages and provide user with all important information.

Response to Arguments

5. Applicant's arguments filed on 5/2/2006 have been fully considered but they are not persuasive.

With respect to applicant's argument that Wolff does not teach transmitting a list of documents stored on an information applicant/appliance from the appliance to the remote computer; has been considered.

In reply: transmitting a list of documents stored on an information applicant/appliance from the appliance to the remote computer is not part of the claimed limitations.

The claim is claiming transmitting information regarding a list of documents stored on an information applicant/appliance from the appliance to the remote computer.

The examiner is interpreting the "information" regarding a list of documents stored on an information applicant/appliance is the "request to print" of e.g., page 12, lines 21-22, applicant's disclosure. The "request or print" is information regarding a list of document displayed by information appliance because it particularly informs the server which documents to be printed from the list of documents stored on an information applicant/appliance.

Wolff, column 8, lines 55-60, clearly teaches to select a document to be printed (request to print) from a Web page of a server such as the Web page displayed in fig. 5B, fig. 6, column 5, lines 33-40.

With respect to applicant's argument that Wolff does not teach received synchronization information; has been considered.

The updated information includes information/ synchronization information such as the list of document name that allows the items in the server to be properly identified or referenced, (see page 12, lines 16-17, applicant's disclosure).

Fig. 5B, fig. 6 Wolff show that the web page accessed by the user includes list of document name that allows the document in the server to be properly identified or referenced.

With respect to applicant's argument Wolff does not teach updating a list of document that is stored on an information applicant/appliance; has been considered.

In reply: Column 7, lines 10-20, teaches web page to be stored in the memory (note: all web page information are inherently being stored or it will be lost and the user would not be able to view the web page of browser 320 such as fig. 5B) to be displayed to the user (column 7, lines 45-50). Clearly, all the Web page information (including the list of document of fig. 5B) would be updated with new information when a new web page is accessed. If a user can access a web page, the web page would be accessed again by the user and every time the web page is accessed, the web page information is updated/replaced with the newly accessed web page.

Therefore, Wolff's system inherently capable of updating a list of document that is stored on an information applicant/appliance when the web page of e.g., fig. 5B is accessed.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).